

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re application of:

Madaline Chirica, et al.

Application No.: 10/667,289

Filed: September 18, 2003

For: NUCLEIC ACIDS ENCODING  
DCRS5 (as amended)

Examiner: J. Seharaseyon

Art Unit: 1647

Conf. No.: 8664

MAIL STOP: Patent Extension  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: GROUNDS UNDER  
37 C.F.R. § 1.702 FOR THE ADJUSTMENT (37 C.F.R. § 1.705 (b)(2)(i) TO (iv))**

Sir:

1. This statement is being submitted in support of the “APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)” to which this statement is attached.

**37 C.F.R. § 1.705 (b)(2)(i)**

2. The patent term adjustment shown on the Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) that was attached to the Notice of Allowance dated March 11, 2008, is 482 days. Applicants believe that this determination of 482 days is an error, due to failure to appreciate that the first requirement for restriction in the case had been withdrawn, and in fact should have been vacated, based on an Office error. It is respectfully submitted that the correct patent term adjustment under 37 C.F.R. § 1.702 is **651 days**.

**37 C.F.R. § 1.705 (b)(2)(ii)**

3. The basis on which Applicants seek adjustment is as follows:

A. The application was filed, along with a Preliminary Amendment cancelling all original claims 1 – 23 and adding new claims 24 – 31, on September 18, 2003.

B. A Restriction Requirement was mailed May 15, 2006 based on the original (cancelled) claim set, not the claims actually pending at the time. This date is mistakenly used in the calculation of the 482 day PTA on the Notice of Allowance.

C. Applicant pointed out the error in a response dated August 15, 2006. This response was filed within 3 months of the mailing date of the Restriction Requirement, and thus does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the application. 37 C.F.R. § 1.704(b).

D. The Examiner indicated that the Restriction Requirement was “withdrawn” in a non-final Office Action dated October 31, 2006. Applicant respectfully submits that the Restriction Requirement should more properly have been vacated.<sup>1</sup> The date of this non-final Office Action is the date that should have been used to calculate the PTA of 651 days. 37 C.F.R. §§ 1.702(a)(1), 1.703(a)(1).

E. A first Notice of Allowance was sent on June 14, 2007, along with a notice that the patent term adjustment would be 482 days.

F. Applicants filed an RCE with an IDS on September 14, 2007.

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<sup>1</sup> The identical issue was raised in the sister application (U.S.S.N. 10/667,290) in which the Examiner indicated in a second Restriction Requirement that the original, erroneous Restriction Requirement was vacated. See U.S.S.N. 10/667,290, Restriction Requirement dated November 1, 2006 at page 2, paragraph 1.

G. A second Notice of Allowance<sup>2</sup> was sent on November 7, 2007, along with a notice that the patent term adjustment would be 482 days.

H. Applicants filed an RCE with an IDS on February 7, 2008.

I. A third Notice of Allowance<sup>3</sup> was sent on March 11, 2008, along with a notice that the patent term adjustment would be 482 days.

J. Accordingly, Applicants request that the PTA be calculated based on the difference between the filing date of September 18, 2003 and the date of the first action on October 31, 2006, less 14 months, less Applicants' delays of 61 days, i.e. **651 days**.

**37 C.F.R. § 1.705 (b)(2)(iii)**

4. The present application is not subject to a Terminal Disclaimer.

**37 C.F.R. § 1.705 (b)(2)(iv)**

5. There were no circumstances in the present application constituting a failure to engage in reasonable efforts to conclude processing or examination of the application.

Applicants respectfully request a favorable decision on the patent term adjustment of 651 days in this case.

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<sup>2</sup> In the interests of clarity, Applicants note out that the Detailed Action accompanying this second Notice of Allowance implies that the application was under final rejection when the RCE was filed, whereas the record indicates that the application had been allowed.

<sup>3</sup> In the interests of clarity, Applicants note out that the Detailed Action accompanying this third Notice of Allowance implies that the application was under final rejection when the RCE was filed, whereas the record indicates that the application had been allowed.

Respectfully submitted,

Date: 6 June 2008

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